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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/479,995	06/07/1995	ROBERT G. PERGOLIZZI	ENZ-(D1)(C2)	8797
28171	7590	09/08/2005	EXAMINER	
ENZO BIOCHEM, INC. 527 MADISON AVENUE (9TH FLOOR) NEW YORK, NY 10022			MARSCHER, ARDIN H	
			ART UNIT	PAPER NUMBER
			1631	
DATE MAILED: 09/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

08/479,995

Applicant(s)

PERGOLIZZI ET AL.

Examiner

Ardin Marschel

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See summary as attached.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: See summary as attached.
Claim(s) objected to: _____
Claim(s) rejected: See summary as attached.
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See summary as attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____

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DETAILED ACTION

Summary of rejections/objections overcome from item # 5 on the enclosed

Advisory Action:

NEW MATTER rejections of claims 510, 516-525, 527, 548, and 549.

Vagueness and Indefiniteness regarding claims 522-525, 527, and 549.

Prior art rejections of claims 506, 516, 517, 520, and 521.

The objection directed to claim 380.

Summary of allowed claims from item # 7 on the enclosed Advisory Action:

Claims 283-362, 364, 365, 382, 383, 400, 401, 403, 404, 406, 407, 409-439, 441-505, 507, 508, 510, 511, and 528-547

Summary of rejected claims from item # 7 on the enclosed Advisory Action.

Claims 366-380, 384-398, 402, and 408

Further explanation of item # 11 on the enclosed Advisory action:

The rejection of claims 366, 370, 374, 375, 379, 384, 388, 392, 393, 397, 402, and 408 based on NEW MATTER is maintained and reiterated from the previous office action, mailed 5/27/05, due to newly amended claim dependencies prior to the Final action, mailed 5/27/05. Claims dependent from the above also are included due to their dependence thus resulting in this NEW MATTER issue being present to support this rejection in instant claims 366-380, 384-398, 402, and 408. Applicants argue in their REMARKS, filed 7/7/05, via a discussion with a table of pending, former base, and pending base claims with "Comments/Changes in Base Claim" on pages 83-86 of said REMARKS as to basis for the claim amending. In response none of these arguments point to disclosure as originally filed to support the present forms of these claims and therefore lacks support to overcome this NEW MATTER rejection. In order to illustrate the NEW MATTER that remains present in these claims, claim 366 is hereby analyzed

as to its present limitations which are not supported as filed. Claim 366 as now pending is dependent from claim 443. Claim 366 further limits claim 443 via requiring "detecting which is directly carried out by means of a detectable signal provided by said signal generating portion". This direct detecting is then applied to the claim 443 process of detecting "an analyte having one or more molecularly recognizable portions thereon" comprising providing a composition of matter with a first and second part as cited in claim 443, forming a complex between the analyte and said composition and detecting said analyte by a signal provided by a signal generating portion or portions present in said complex. Previously claim 366 depended from claim 363 which is traced to a newly submitted amendment, filed 4/12/96. Claim 363, filed 4/12/96, cites the providing, forming, and detecting limitations above but does not itself cite the composition utilized therein but rather depends from then pending claims 283, 285, 287, 289, 291, or 292. Thus, the limitations previously cited regarding the composition practice of claim 366 is supported via the compositions present in claims 283, 285, 287, 289, 291, or 292 on 4/12/96. Consideration of claims 283, 285, 287, 289, 291, or 292 as present on 4/12/96 reveals that they do not contain description of the now present claim 443 from which claim 366 now depends. In particular, claim 443 requires a second part which is not present in any of claims 283, 285, 287, 289, 291, or 291 in the 4/12/96 amendment. The second part of now pending claim 443 requires "one or more non-radioactive signalling entities substantially incapable of binding to or hybridizing with the molecularly recognizable portion on said analyte". No such signalling entities are present in any of claims 283, 285, 287, 289, 291, or 291 in the 4/12/96 amendment. It is noted that claims 283 etc. were newly added in the 4/12/96 amendment and the amending of claim 366 to depend from claim 443 was submitted well after claim 443 was submitted with the added limitations as noted above. Claim 443 was not present in the 4/12/96

amendment. It is also noted that claims 283 etc. has been amended to now contain the above described claim 443 limitations but that claims 283 etc. never contained these limitations while the claim dependency from claim 366 was pending. Therefore, applicants' arguments that the claim 366 claim dependency is only to correct for a cancelled claim is inconsistent with the claim 366 dependency and limitations therein before claim 363 was cancelled which in turn linked the claim 366 composition with the previously pending (4/12/96) forms of claims 283 etc. which lacked the above described additional claim 443 limitations. In summary, to reiterate applicants' arguments themselves fail to provide written basis for claim 366 as now pending as dependent from claim 443 limitations even considering the prosecution history. Applicants also did not point to any original disclosure as filed regarding the now present, as dependent claims, for claim 366 etc. which remain rejected as therefore containing NEW MATTER. The other claims 370 etc. suffer from this same altered content regarding NEW MATTER and inconsistent dependencies as previously pending as claim 366. Reliance also on claim forms and contents present during and intermediate to a long prosecution history does not overcome this rejection because this rejection also relies on the lack of disclosure as filed for the present claim subject matter via dependencies as present in the above listed claims 366 etc.

Applicants are reminded of the availability of a second submission under 37 CFR 1.129(a).

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (571) 273-8300.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., Supervisory Patent Examiner, whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 5, 2005

Ardin H. Marschel 9/5/05
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER